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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/956,888	09/21/2001	Sachiko Tajima	211653US0	2424

22850 7590 04/10/2002

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EXAMINER

GOLLAMUDI, SHARMILA S

ART UNIT	PAPER NUMBER
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1616

DATE MAILED: 04/10/2002

41

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/956,888

Applicant(s)

TAJIMA ET AL.

Examiner

Sharmila S. Gollamudi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 September 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

Claims 1-16 are included in the prosecution of this application.

Preliminary Amendment A entered on November 28, 2001 is acknowledged.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 5- 6 and 10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 5 recites the broad recitation

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"ingredient A ranges from .1 to 1%", and the claim also recites "especially from .3 to .8%" which is the narrower statement of the range/limitation.

Claim 10 recites "wherein the aromatic alcohol solvent is ..." Is it the applicant's intention that the solvent is a mixture of the recited aromatic solvents? If this is not the case, the proper Markush format is "selected from the group consisting of A, B, and C."

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, 5-6, 9-11, and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by Sekiguchi et al (5190747).

Sekiguchi et al disclose a perfume composition containing cis-3-hexanol (.5%), instant fragrances in claims, and an aromatic alcohol (2.5%) (phenyl ethyl alcohol) (Note col. 23, Perfume II). This perfume is added into a shampoo containing surfactants and silicone derivatives (Note example 27).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

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the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-6, 9-11, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 05310543 in view of Sekiguchi et al, cited above.

JP 05310543 teaches a hair dye composition containing perfume such as cis-3-hexanol to produce a dye without an unpleasant odor (Note abstract).

JP does not teach other fragrances in the formula.

Sekiguchi et al disclose a perfume composition containing cis-3-hexanol (.5%), instant fragrances in claims, and an aromatic alcohol (2.5%) (phenyl ethyl alcohol) (Note col. 23, Perfume II). The perfume formulation is added into a hair formulation.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of JP and Sekiguchi. One would be motivated to do so since Sekiguchi teaches instant perfume composition with several fragrance compounds to yield at least an additive fragrance odor and JP teaches a pleasant smelling hair dye formulation.

Claims 1-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lang et al (5938795) in view of Sekiguchi et al (5190747) in view of JP 05310543.

Lang et al teach a hair dye composition containing ammonia in instant range, aromatic alcohol, a color-developing substance, and a coupling agent (Note example 3). Further, the composition may also contain perfumes (col.8, lines 1-7).

Lang et al do not specify the perfume used.

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Sekiguchi et al disclose a perfume composition containing cis-3-hexanol (.5%), instant fragrances in claims, and an aromatic alcohol (2.5%) (phenyl ethyl alcohol) (Note col. 23, Perfume II). The perfume formulation is added into a hair formulation.

JP 05310543 teaches a hair dye composition containing perfume such as cis-3-hexanol to produce a dye without an unpleasant odor (Note abstract).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use Sekiguchi et al's perfume composition in Lang et al's hair dye composition to mask the unpleasant odor produced by some of the components in the formulation as taught by JP 05310543.


Conclusion

Any inquiry concerning this communication from the examiner should be directed to Sharmila S. Gollamudi whose telephone number is (703) 305-2147. The examiner can be normally reached M-F from 7:30 am to 4:15pm.

If attempts to reach the examiner by the telephone are unsuccessful, the examiner's supervisor, Jose Dees, can be reached at (703) 308-4628. The fax number for this organization where this application or proceeding is assigned is (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist, whose telephone number is (703) 308-1235.

SSG


April 5, 2002


JOSE G. DEES
SUPERVISORY PATENT EXAMINER

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